

Cont
space includes a cavity defined by said third panel and said partitions, said cavity having a width at the top thereof that is substantially greater than the panel thickness at the bottom of said third panel;

a wall having a width approximately equal to the first width and formed by building material received in said first and second spaces; and

a finger formed by building material received in said cavity, said finger defining with said third panel a supporting shelf, and said shelf being integral with said wall.

REMARKS

I. Summary of the Office Action

Claims 17, 23, 24 and 41 stand rejected because of a purported violation of the recapture doctrine. Specifically, the Office Action states that "[i]t has been determined . . . that because of the Reasons for Allowance in the parent application there is recapture."

Claims 1-41 are rejected as being based upon an allegedly defective reissue oath/declaration.

II. Interview Summary

The Applicant's undersigned representatives wishes to thank Examiner Stephan, Friedman and Dorner for the courtesies extended during the Examiner's Interview of February 26, 2002. The arguments discussed at the interview are summarized in the following remarks traversing the rejections.

III. The Rejection Based on a Defective Reissue Declaration

Applicant filed a supplemental reissue declaration with their amendment and response of December 1, 2000. The reissue declaration complies with the requirements of 35 U.S.C. § 251 and 37 C.F.R. § 1.175. Accordingly, Applicant requests that the rejection of claims 1-41 based

on a defective reissue declaration be removed.

IV. The Rejection of the Claims Under the Recapture Rule

As discussed during the Examiner's interview, the claims have been rejected in accordance with the PTO's policy directive for examination of broadening reissue applications. See Memorandum from the Deputy Assistant Commissioner for Patent Policy and Projects Stephan G. Kunin to the Patent Examiner Corps, Applying the Recapture Rule to Reissue Applications, September 21, 1999. Applicants traverse the rejections of the claims for the reasons set forth below.

A. The PTO Policy for Determining Recapture Questions Improperly Focuses All Attention on whether the Applicant submits a Response to the Reasons for Allowance

Controlling Federal Circuit precedent states that a reissue claim is invalid under the recapture rule if the broadened subject matter of the reissue claim relates to subject matter surrendered during prosecution and the claim is not materially narrowed in other respects. See e.g., Hester Industries v. Stein, Inc., 142 F.3d 1472, 1480-1484 (Fed. Cir. 1998); Pannu v. Storz Instruments, Inc., 258 F.3d 1366, 1371 (Fed. Cir. 2001). Under this precedent, the question of whether an Applicant is attempting to recapture subject matter that was surrendered during original prosecution depends upon the arguments and/or claim amendments made by the Applicant. See e.g., Hester, 142 F.3d 1472, 1480-1484; Pannu, 258 F.3d 1366, 1371.

During the Examiner's interview, Applicant's representative was informed that the current PTO policy mandates that Applicant's arguments during the original prosecution are irrelevant to the question of whether the reasons for allowance reflects a surrender of subject matter by the Applicant where there is no rebuttal by the Applicant. This aspect of the PTO's Reissue Policy directly conflicts with the relevant case law. For example, in Dethmers

Manufacturing Co. v. Automatic Equip. Mfg, 23 F. Supp. 2d 974 (ND Iowa 1998), aff'd on other grounds, 272 F.3d 1365 (Fed. Cir. 2001), the question of recapture of surrendered subject matter was decided in favor of the patentee after a review of both the examiner's reasons for allowance and applicant's responses to the examiner's office action. The court's ultimate decision as to whether the recapture rule was violated rested on the content of an official action and applicant's response thereto. The Court found that there was no recapture, notwithstanding the fact that the reissue claim deleted a limitation included in the examiner's reasons for allowance.

Thus, even if the case law does suggest that an Examiner's reasons for allowance could be an appropriate source of evidence relevant to whether the Applicant has surrendered subject matter, the case law clearly does not support the PTO's novel position that an Examiner's Reasons for Allowance (hereinafter "RFA") can indicate surrendered subject matter regardless of the arguments Applicant made in the file history. There is no support in the case law for this newly-minted, bright line rule the PTO is attempting to impose on Applicant.

B. The rejections of the claims improperly applies the Recapture Rule because the rejections do not take into account statements by the Applicant during prosecution

In the present case, no statements by the Applicant were considered as relevant to the question of surrendered subject matter. The Office Action merely states that "because of the reasons for allowance in the parent application there is recapture." Indeed, during the Examiner's interview it was confirmed that any statements by Applicant were deemed irrelevant to the question of surrender of subject matter because, according to the PTO, the Applicant did not rebut the RFA. Such an interpretation of the Federal Circuit's test for recapture is erroneous. Applicant respectfully traverses the rejection of claims 17-41 under the recapture rule because the rejection does not satisfy the case law requirements that an alleged surrender of subject matter by the Applicant be supported by arguments and/or claim amendments by the Applicant.

In this case the claims were not amended and the PTO points to no file history supporting the alleged recapture. Accordingly, the rejection is erroneous and should be withdrawn.

C. Even assuming arguendo the PTO's view of the case law is correct, it cannot retroactively apply to this case

The patent at issue in this reissue application is U.S. Pat. No. 5,567,600, which issued in August 1997 from application serial no. 262,505, which was filed June 20, 1994 (hereinafter the "505 application"). When the RFA was received by the Applicant in 1995, the applicable PTO regulation stated, in pertinent part:

If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. . . The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure to file such a statement shall not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.

37 C.F.R. § 104(e) (emphasis added). Yet, the present rejection relies upon the presumption that the Applicant agreed with the Examiner's reasoning because the Applicant did not substantively rebut the Examiner's reasons for allowance. In the present case, no such presumption can be inferred because the current version of 37 C.F.R. § 104(e), which deletes the last sentence in the former rule, was not effective until September 7, 2000, when the Patent Business Goals Act was implemented. See 65 Fed. Reg. 54,633. The PTO rejection of claims 17, 23, 24 and 41 is improper and unfair because it relies upon a retroactive application of the new provisions of 37 C.F.R. § 104(e), which were not in affect during original prosecution. Accordingly, Applicant respectfully requests that the recapture rejection be withdrawn for this independent reason.

Moreover, the law requires that a surrender of subject matter cannot be based on "equivocal" statements by the Applicant. See e.g., Hester. Failure to respond substantively to

the Examiner's reason for allowance in this case cannot amount to an unequivocal statement of acquiescence in the Examiner's reasoning under the applicable PTO rules in force at the time. For this additional reason, Applicant traverses the rejections under the recapture rule.

D. *The PTO rationale for rejecting the claims in this case contravenes the logic of the recapture rule*

Two of the primary reasons for the recapture rule are (1) that a patentee should be bound to deliberate assertions made in order to obtain allowance, and (2) fairness to the public who rely upon the unmistakable assertions by the Applicant in support of patentability. See e.g., Hester. The necessary predicate to these policies is that a file history actually articulates a limitation in the claim or feature of the invention that the public can identify as the patentable distinction over the art, i.e., a limitation or feature that is more important than the other limitations of the claim. Absent evidence of reliance upon a particular limitation or feature by the Applicant, all limitations are deemed to be equally material under the law.

Applicant additionally traverses the rejection of at least claims 17, 23 and 41 for the following reasons. The PTO recapture rejection relies on the following statement as alleged evidence of surrendered subject matter: "two parallel panels connected by a bridging member as claimed." It is undisputed that bridging members and parallel panels are notoriously well known in the art, as is the combination of the two elements. Indeed, in the context of building components, the presence of bridging members necessarily means that panels are in some way involved since one of the functions of a bridging member is to connect a pair of panels. When viewed in this light, the PTO's belief that the statement "two parallel panels connected by a bridging member as claimed" evidences a surrender of subject matter defies common sense. One of ordinary skill in the art reading the RFA cannot conclude that there is any particular limitation or feature in the claims that is of more importance to patentability than any other limitation or feature in the claims. The RFA does nothing more than inform the reader that the claims relate

to two well-known concepts in the building component art. Indeed, the PTO's reliance on "two parallel panels connected by a bridging member as claimed" as purported evidence of surrendered subject matter is tantamount to concluding that a RFA that simply block-quotes an entire claim evidences a surrender sufficient to prevent recapture of any limitation.

Stated another way, the statement "two parallel panels connected by a bridging member as claimed" does not evidence surrender of subject matter because it merely serves as a shorthand way of incorporating all of the limitations of the claims into the RFA. During the Examiner's interview, Examiner Dorner suggested that an RFA that simply block quotes an entire claim cannot be used as a basis for rejecting claims under the recapture rule. Nevertheless, Examiner Dorner took the view that the phrase "two parallel panels connected by a bridging member as claimed" refers to specific limitations in the claims. Applicant respectfully disagrees with Examiner Dorner and requests reconsideration because the statement, when properly viewed from the perspective of one of ordinary skill in the art of building components, merely accords equal weight to each claim limitation in the claims. Thus, the public cannot identify from this statement one limitation in the claims that is of any more importance to patentability than any other limitation in the claims. For this reason, the rejections of claims 17, 23 and 41 under the recapture rule is additionally erroneous and should be withdrawn.

E. *Recapture is not present under a correct interpretation of the case law*

Even if the PTO were to properly apply the case law in the present case, Applicant's reissue claims 17-41 do not recapture surrendered subject matter. During the original prosecution, Applicant's originally filed claims were initially rejected. Applicant then submitted a response traversing the rejections without amendments to the claims. In a subsequent office action, the Examiner allowed claims 1-16.

In the Applicant's response to the Examiner's first office action, Applicant discussed the distinctions of the claimed building component and/or bridging member (issued claims 1-12) and

brickshelf (issued claims 13-16) over the prior art. In regards to claims 1-12, Applicant discussed the advantages of the particular shape of the bridging member in defining over the art. Reissue claims 17-23 and 41 retain all of the distinctions referred to in the Applicant's response to the Examiner's first office action. For at least this reason, there is no surrender of subject matter for reissue claims 17-23 and 41.

As for claims 13-16, Applicant's response to the Examiner's office action addressed the prior art *Smith* patent. This patent teaches using concrete blocks. In traversing this rejection, Applicant pointed to the clear distinction between a concrete block supporting, e.g., a brickshelf, and the plastic forming panels in the claims. Applicant's reissue claims 24-41 retain the same limitations of a plastic forming panel having sufficient strength for supporting, e.g., a brickwall, that were argued by the Applicant during the original prosecution. For at least this reason, there is no recapture of surrendered subject matter for reissue claims 17-23 and 41.

V. Claims 1-16, 18-22 and 25-40

Claims 1-16, 18-22 and 25-40 are believed to be allowable in light of the comments above traversing the rejection based upon the reissue oath. Dependent claims 18-22 and 25-40 satisfy all of the requirements for reissue under 35 U.S.C. § 251. Furthermore, each of these claims recite additional features of invention that are separately patentable. For these reasons, allowance of claims 1-16, 18-22 and 25-40 is earnestly solicited.

VI. New Claims 42-45

Applicant has added new claims 42-45. These claims are patentable over the prior art and do not attempt to recapture subject matter surrendered during original prosecution. Allowance of claims 42-45 is earnestly solicited.

VII. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration of this application and the timely allowance of the pending claims. The Examiner is invited to contact the undersigned at (202) 739-5772 if there remains any outstanding issues that can be addressed to expedite allowance.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTION PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,
MORGAN, LEWIS & BOCKIUS LLP

Date: February 28, 2002

By:



James L. Reed

Registration No. 43,877

Richard S. Meyer

Registration No. 32,541

Morgan, Lewis & Bockius LLP
1800 M Street, N.W.
Washington, D.C. 20036-5869
(202) 467-7000
Customer No. 009629